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| 09/452,188 | 12/02/1999 | SHOICHI YAMAGUCHI | 862.3158 | 9981 |
| 5514 | 7590 | 05/07/2004 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | WON, MICHAEL YOUNG | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2155 | |

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/452,188

Applicant(s)

YAMAGUCHI, SHOICHI

Examiner

Young N Won

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Amended claims 1, 4, 5, 8, 10, and 18 have been examined and all remaining claims have been re-examined. Claims 1-18 are pending with this action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (US 5608786 A) in view of Rasmussen (US 5521719 A).

Independent:

As per claim 1, Gordon teaches of a communication apparatus (see col.1 line 66: "messaging system") connected to a communication network (see Fig.1, #4 & #10), said apparatus comprising: destination designating means for designating a destination apparatus (see col.2, lines 25-28 & 44-54); facsimile communication means for transmitting the transmission information inputted by said input means to a destination

apparatus in accordance with facsimile communication specifications (see Fig.1 # 10 & #14 and col.3 lines 41-44); encryption means for encrypting the transmission information inputted by said input means (see col.9, lines 18-33) without using the communication network, wherein the transmission information is encrypted before transmitted through the communication network (see col.9, lines 26-28: "first.. telephone legs of the communication") to maintain confidentiality of the transmission information (see col.9, lines 26-33); electronic-mail communication means for transmitting the transmission information inputted by said input means or encrypted by said encryption means to a destination apparatus in accordance with electronic-mail specifications (see col.2 lines 4-6); communication designating means for causing transmission of the transmission information by selecting either said facsimile communication means or said electronic-mail communication means (see col.2, lines 44-54 and col.3 lines 36-38); security designating means for designating whether the transmission information is confidential information or not (see col.9, lines 28-33); and control means for controlling said facsimile communication means, said encryption means, and said electronic-mail means such that (see col.9, lines 19-26: it is implicit that when Gordon says "transparently to the sender and the receiver", there is a means of control by the "state of the art" system), if the transmission information has been designated as being confidential by said security designating means, said facsimile communication means transmits the inputted transmission information to the destination apparatus by facsimile transmission (see col.2, lines 50-54 and col.9 lines 23-26) through the communication network, when said facsimile communication means has been designated by said

communication designating means (see col.3, lines 30-35), and said electronic-mail communication means sends the encrypted transmission information to the destination apparatus by electronic mail through the communication network, when said electronic-mail communication means has been designated by said communication designating means (see col.2 lines 31-35 and col.2, lines 30-35).

Gordon does not explicitly teach ~~an~~ of an input means for inputting transmission information to be transmitted to the destination apparatus designated by said destination designating means without using the communication network, but it is implicit that all devices uses for the purpose of transferring information such as a fax, laptop, telephone, personal computer, and scanner (see Fig.1), all have an input means such as number pad, keyboard, mouse, button, and software to input telephone numbers or email addresses.

Gordon does not explicitly teach that the security is designated according to an operation of a confidential button, wherein the confidential button is used when confidentiality of the transmission information is to be maintained. Rasmussen teaches of designated security according to an operation of a confidential button, wherein the confidential button is used when confidentiality of the transmission information is to be maintained (see Fig.3 and col.7, lines 31-50). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Rasmussen within the system of Gordon by implementing a button to initiate security within the communication apparatus because such an implementation gives the control

to the user according to his/her preference (see Rasmussen: col.14, line 65 to col.15, line 10: "user selects").

As per claim 10, Gordon teaches of a communication method (see col.1 lines 5-13) in a communication apparatus (see col.1 line 66: "messaging system") connected to a communication network (see Fig.1, #4 & #10), said method selectively executing facsimile communication for transmitting transmission information to a destination apparatus in accordance with facsimile communication specification (see Fig.1 # 10 & #14 and col.3 lines 41-44) and electronic-mail communication for transmitting transmission information to a destination apparatus in accordance with electronic mail specifications (see col.2 lines 4-6), and said method comprising the following steps, in a case where the transmission information is to be transmitted to a destination apparatus as confidential information (see col.9, lines 26-33): an apparatus designation step of designating a destination apparatus (see col.2, lines 25-28 & 44-54); security designating step for designating whether the inputted transmission information is confidential information or not (see col.9, lines 28-33); a transmission step of transmitting the transmission information inputted in said input step to the destination apparatus as is by facsimile transmission through the communication network, when communication is performed in accordance with facsimile communication and the transmission information has been designated as being confidential information (see col.12, lines 29-48); and encrypting the transmission information inputted in said input step (see col.9, lines 18-33) without using the communication network (see col.9, lines 26-28: "first.. telephone legs of the communication"), if the transmission information has

been designated as being confidential information and then sending it to the destination apparatus by electronic mail through the communication network to maintain confidentiality of the transmission information, when communication is performed in accordance with electronic-mail communication (see col.12, lines 29-48).

Gordon does not explicitly teaches of an input step of inputting transmission information to be transmitted to the destination apparatus designated in said destination step without using the communication network, but it is implicit that all devices uses for the purpose of transferring information such as a fax, laptop, telephone, personal computer, and scanner (see Fig.1), all have an input step by employing number pad, keyboard, mouse, button, and software to input data otherwise data would not exist for transmitting.

Gordon does not explicitly teach that the security is designated according to an operation of a confidential button, wherein the confidential button is used when confidentiality of the transmission information is to be maintained. Rasmussen teaches of designated security according to an operation of a confidential button, wherein the confidential button is used when confidentiality of the transmission information is to be maintained (see Fig.3 and col.7, lines 31-50). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Rasmussen within the system of Gordon by implementing a button to initiate security within the communication apparatus because such an implementation gives the control to the user according to his/her preference (see Rasmussen: col.14, line 65 to col.15, line 10: "user selects").

As per claim 18, Gordon teaches of a communication apparatus (see col.1 line 66: "messaging system") connected to a communication network (see Fig.1, #4 & #10), said apparatus comprising: a destination designating unit adapted to designate a destination apparatus (see col.2, lines 25-28 & 44-54); a facsimile communication unit adapted to transmit the transmission information inputted by said input unit to a destination apparatus in accordance with facsimile communication specifications (see Fig.1 # 10 & #14 and col.3 lines 41-44); an encryption unit adapted to encrypt the transmission information inputted by said input unit (see col.9, lines 18-33) without using the communication network, wherein the transmission information is encrypted before transmitted through the communication network to maintain confidentiality of the transmission information (see col.9, lines 26-33); an electronic-mail communication unit adapted to transmit the transmission information inputted by said input unit or encrypted by said encryption unit to a destination apparatus in accordance with electronic-mail specifications (see col.2 lines 4-6); a communication designating unit adapted to cause transmission of the transmission information by selecting either said facsimile communication unit or said electronic-mail communication unit (see col.2, lines 44-54 and col.3 lines 36-38); a security designating unit adapted to designate whether the transmission information is confidential information or not (see col.9, lines 28-33); and control unit adapted to control said facsimile communication unit, said encryption unit, and said electronic-mail communication unit (see col.9, lines 19-26: it is inherent that when Gordon says "transparently to the sender and the receiver", there is a means of control by the "state of the art" system) such that, if the transmission information has

been designated as being confidential information by said security designating unit, said facsimile communicating unit transmits the transmission information to the destination apparatus by facsimile transmission through the communication network, when said facsimile communication unit has been designated by said communication designating unit (see col.3, lines 30-35), and said electronic-mail communication unit sends the encrypted transmission information to the destination apparatus by electronic mail through the communication network, when said electronic-mail communication unit has been designated by said communication designating unit(see col.2 lines 31-35 and col.2, lines 30-35).

Gordon does not explicitly teaches of an input unit adapted to input transmission information to be transmitted to the destination apparatus designated by said destination designating unit without using the communication network, but it is inherent that all devices uses for the purpose of transferring information such as a fax, laptop, telephone, personal computer, and scanner (see Fig.1), all have an input means such as number pad, keyboard, mouse, and software to input telephone numbers or type email addresses.

Gordon does not explicitly teach that the security is designated according to an operation of a confidential button, wherein the confidential button is used when confidentiality of the transmission information is to be maintained. Rasmussen teaches of designated security according to an operation of a confidential button, wherein the confidential button is used when confidentiality of the transmission information is to be maintained (see Fig.3 and col.7, lines 31-50). It would have been obvious to a person

of ordinary skill in the art at the time the invention was made to employ the teachings of Rasmussen within the system of Gordon by implementing a button to initiate security within the communication apparatus because such an implementation gives the control to the user according to his/her preference (see Rasmussen: col.14, line 65 to col.15, line 10: "user selects").

Dependent:

As per claims 2-3 and 11-12, Gordon further teaches of a computer program product embodying a computer program for implementing functions described in claims 1 and 10, and a computer-readable recording medium storing a computer program for implementing functions described in claims 1 and 10 (see col.6 lines 18-20).

As per claims 4, 5, and 13, Gordon further teaches wherein, if the destination apparatus possesses a private security function, said facsimile communication means checks to determine whether the destination apparatus possesses a private security function by inquiring as to whether the destination apparatus possesses the private security function when a communication path to the destination apparatus is formed and transmits the inputted transmission information by confidential communication utilizing the private security function, when the transmission information has been designated as being confidential by said security designating means (see col.9 lines 18-28).

As per claims 6, 7, 14, and 15, Gordon further teaches of a computer program product embodying a computer program for implementing functions described in claims 5 and 13 and a computer-readable recording medium storing a computer program for

implementing functions described in claims 5 and 13 (see col.6 lines 18-20 and col.10 lines 21-23).

As per claims 8, Gordon further teaches wherein said security designating means makes a determination that the transmission information is confidential when transmission by a confidential communication is designated (see col.6 lines 28-33).

As per claims 9 and 16, Gordon further teaches wherein said input means comprises a document reader and the transmission information, is inputted by reading a document using the document reader (see col.1 lines 5-10).

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (US 5608786 A) and Rasmussen et al. (US 5521719 A) further in view of Yamada (US 5521719 A). Gordon and Rasmussen teaches all the limitations of claim 17 including wherein the communication network includes at least a telephone network, but he does not teach that the communication network includes a LAN. Yamada teaches wherein the communication network includes at least a telephone network and a LAN (see Fig.9, #117 & #123 and col.4, lines 43-48). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Yamada within the system of Gordon by implementing a LAN network and a PSTN network within the communication apparatus and method because, Gordon teaches us that other networks may be employed (see col.10, lines 6-9), thus it would be obvious to employ Local Area Network if there was a demand for such a network for this system.

Response to Arguments

4. Applicant's arguments filed September 16, 2003 have been fully considered but they are not persuasive. Explanations of the reasons are stated below.

In response to the arguments of claims 1, 10, and 18, Gordon clearly teaches that other "additional security can include predetermined encryption of the communication on either the **first** or last **telephone legs of the communication**". Clearly, predetermined encryption on the first telephone leg means that the data from the sender to the UniPost access provider is encrypted! Gordon also invites other encryption schemes to be employed into his system. One of ordinary skill in the art knows that many cryptographic schemes are available wherein the data is encrypted prior to transmission. Such feature is not novel as taught by Gordon as well as the secondary reference.

New reference Rasmussen et al (US 5,222,136 A) clearly teaches the new element of the amended independent claims.

Also, the element of inputting information without using the communication is inherent as stated in the claim rejections because Gordon teaches of multiple devices (see Fig.1). Unless the data employed for transmission is retrieved from a remote database or repository (not taught or suggested by Gordon), such limitations are clearly

implicit. One cannot transmit data unless one has data to send. Likewise, one cannot have data unless one is either inputted or received.

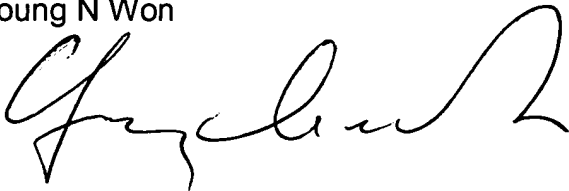
5. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Young N Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-Th: 6AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Young N Won



April 28, 2004


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER